REMARKS

This application pertains to a novel antistatic pressure-sensitive adhesive tape.

Claims 1, 3, 5-13 and15 are pending; claims 2, 4 and 14 being cancelled by this amendment.

Claim 14 stands objected to because previously identified as "currently amended" whereas it properly should have been identified as "previously presented". Applicants are including a corrected listing of claims with this response, in which claim 14 is now being cancelled and identified accordingly identified as "cancelled". The objection to claim 14 should accordingly now be withdrawn.

Claims 4 and 12-15 stand rejected under 35 U.S.C. 112, first paragraph, because claim 12 was amended to substitute the --and-- for the word "or" in the Markush group expression. The Examiner is concerned that the specification does not provide support for a combination of "electrically conductive polymers **and** electrically conductive organic salts".

The rejection of claim 4 is obviated by cancellation of the claim.

Further, the substitution of the word --and-- for the word "or" in claim 12 simply corrects the form of the Markush language, which properly uses the term --and--, and does not add a combination of components to the claim. This constitutes a formal

correction to the Markush language, and does not constitute new matter.

The rejection of claims 4 and 12-15 under 35 U.S.C. 112, first paragraph should therefore now be withdrawn.

Claims 1 and 5 stand rejected under 35 U.S.C. 102(b) as anticipated by Wallner (US 3,146,882).

Wallner teaches that his antistatic polymer is a hydrophilic film-forming ionogenic polymer which provides ionic conductivity in the presence of moisture (col. 2, lines 28-30). Nowhere does Wallner teach or suggest anything about a primer layer that contains conductive particles. In fact, the Examiner points out that Wallner is silent as to teaching the presence of electrically conductive particles in the PSA of his/her invention.

In a determined effort to advance the prosecution of this application, Applicants have now limited their claims to primer layers comprising electrically conductive **particles**, such as were recited in original claim 2. In as much as Wallner neither teaches nor suggests the inclusion of electrically conductive particles in a primer layer, Applicants' claims cannot be seen as anticipated by Wallner and the rejection of claims 1 and 5 under 35 U.S.C. 102(b) as anticipated by Wallner (US 3,146,882) should now be withdrawn.

Claim 6 stands rejected under 35 U.S.C. 102(b) as anticipated by or, in the

alternative, under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882).

The Examiner contends that although Wallner is silent as to teaching the first adhesive layer exhibits shrinkback, it is reasonable to presume that said features of shrinkback is present in the adhesive of Wallner.

Claim 6 depends from claim 1, and the differences between the invention defined in Applicants' claim 1 and anything that can be found in the Wallner reference have been discussed above. Even if Wallner disclosed a PSA having a shrinkback, this would not overcome the differences discussed above. In addition, there is no basis for the Examiner's "presumption" that Wallner's adhesive possesses a shrinkback. Shrinkback is a measure of orientation (page 17, lines 13-14), and there is nothing in Wallner that would teach or suggest that his adhesive is oriented. Accordingly, Wallner's adhesive cannot be presumed to have a shrinkback, and even if it did, this would not overcome the differences between Applicants' antistatic pressure sensitive adhesive tape and anything that can be found in the Wallner reference. Moreover, there is nothing in the Wallner reference that would lead those skilled in the art to make the changes that would be necessary to overcome the differences discussed above. The rejection of claim 6 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) should therefore be withdrawn.

Claims 2-4 and 11-13 stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 above and further in view of Akhter (US

5,958,537).

Applicants have already pointed out that the Akhter reference relies on **both** conductive particles within the primer layer **and conductive particles in the PSA layer**, which extend from a first surface of the PSA layer to a second surface of the PSA layer; the first surface of the PSA layer being in intimate and binding contact with the second surface of the primer layer.

Those skilled in the art would therefore read Akhter as requiring conductive particles in both the adhesive layer and the primer layer, and would not be led to add conductive particles to the primer layer without also adding them to the PSA layer.

To this the Examiner responds that Wallner wants the PSA that is electrically insulative and that those skilled in the art therefore would not be motivated to add the electrically conductive particles of Akhter to the PSA of Wallner.

However, Akhter teaches that, in accordance with his invention, conductive particles bridge or span the height or depth of the adhesive such that they serve as conductive bridges from open surface 6 to conductive primer layer 3 (col. 5, lines 1-5). Akhter also teaches, at col. 1, lines 52-57, that "...since only the adhesive is involved in the peeling process, only the adhesive stores the charge. If the adhesive is conductive, the charge can be dissipated harmlessly". Akhter then goes on to teach that the PSA should have conductive particles which extend from one surface of the adhesive to the other, and that one of the surfaces of the adhesives should be in contact with the

conductive primer layer (col. 2, lines 13-18). Those skilled in the art would clearly recognize that the conductive particles are necessary in the PSA in order to conduct the charge from the substrate to which the adhesive is attached, through the PSA, and into the conductive primer. Those reading Akhter would therefore find that there would be no purpose in having an electrically conductive primer unless it was combined with an adhesive that had electrically conductive particles dispersed in it which were capable of conducting an electrical charge from one surface of the PSA to the other, i.e., from a substrate, through the PSA, and on to the primer.

Dispersing electrical conductive particles in the primer of the Akhter reference would serve no purpose unless provisions were also made to conduct a charge from the substrate, through the PSA, and on to the primer.

Those skilled in the art would therefore see absolutely no purpose in dispersing electrically conductive particles in a primer layer without also including electrically conductive particles in the PSA.

In view of this, Applicants' invention, which requires conductive particles in only the primer layer and which does not have any conductive particles in the PSA layer, is truly surprising. Those skilled in the art reading Akhter would find it truly surprising that Applicants adhesive tape, which has electrically conductive particles only in the primer layer, could pass the antistatic test (see Table 2, page 24, of Applicants' specification).

Applicants' claims cannot therefore be seen as obvious over any combination of

Wallner and Akhter, and the rejection of claims 2-4 and 11-13 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Akhter (US 5,958,537) should now be withdrawn.

Claims 8 and 9 stand rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Kitamura et al (US 5,759,679).

The differences between Applicants' antistatic pressure sensitive adhesive tape and anything that can be found in the Wallner reference are discussed above. The additional layers that the Examiner finds in the Kitamura reference do not in any way overcome any of these differences. More specifically, Kitamura's teaching that a PSA layer can be applied on one or both sides of the foamed substrate (carrier), and Kitamura's teaching that a primer layer can be applied to the surface of the carrier layer, do not compensate for the failure of the Wallner reference to teach or suggest the use of electrically conductive particles in the primer layer.

Accordingly, no combination of Wallner and Kitamura could possibly lead to the invention defined by Applicants' claims, and the rejection of claims 8 and 9 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of Kitamura et al (US 5,759,679) should now be withdrawn.

Claim 10 stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1, and further in view of Luhmann et al (US 6,395,389

B1).

The Examiner acknowledges that Wallner is silent with respect to disclosing the PSA tape in the form of punched product, but relies on Luhmann for a teaching of punched adhesive strip sections covered on one side with a release laminate. The Examiner then concludes that it would be obvious to produce "the" tape in the form of a punched product because doing so involves routine skill in the art.

No combination of Wallner and Luhmann could ever lead to the pressure sensitive adhesive tape of Applicants' claim 1 in the form of a punched product, as recited in Applicants' claim 10, because the antistatic pressure sensitive adhesive tape of Applicants' claim 1 is different than and non-obvious over the adhesive tape of Wallner, as discussed above. If the adhesive tape of the Wallner reference were provided in the form of a punched product, such a punched product would be different than the pressure-sensitive adhesive tape of Applicants' claim 1 in the form of a punched product. The Adhesive tape of Applicants' claim 1 has electrically conductive particles in the primer layer, but not in the PSA layer; whereas the adhesive tape of the Wallner reference has a primer layer which comprises an antistatic polymer, such as a hydrophilic film-forming ionogenic polymer which provides ionic conductivity in the presence of moisture.

Walner's adhesive tape, even if presented in the form of a punched product, would therefore be completely different than the punched product of Applicants claim 10 and the rejection of claim 10 under 35 U.S.C. 103(a) as obvious over Wallner (US

3,146,882) as applied to claim 1, and further in view of Luhmann et al (US 6,395,389 B1) should therefore now be withdrawn.

Claim 14 stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) in view of Akhter (US 5,958,537) as applied to claim 1 and further in view of Craig et al (US 6,299,799 B1).

This rejection is obviated by cancellation of claim 14.

Claim 15 stands rejected under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of De Jonge et al (US 6,284,837). The Examiner contends that it would be obvious to use the polymethacrylate PSA of De Jonge as the PSA in Wallner's invention. Using polymethacrylate as the PSA in the Wallner adhesive tape will not overcome any of the differences pointed out above between Applicants' invention and the adhesive tape disclosed by Wallner, and will not bring the disclosure of the Wallner reference any closer to the antistatic pressure sensitive adhesive tape defined by Applicants' claim 15 (which depends from, and incorporates the limitations of, claims 5 and 1).

The rejection of claim 15 under 35 U.S.C. 103(a) as obvious over Wallner (US 3,146,882) as applied to claim 1 and further in view of De Jonge et al (US 6,284,837) should therefore now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1, 3, 5-

13 and15 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited. Should the Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116 be entered for the purpose of placing the prosecution record in better condition for appeal.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
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